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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,048	03/02/2000	Robert Barritz	P/1318-73	5346

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EXAMINER	
HENEGHAN, MATTHEW E	
ART UNIT	**PAPER NUMBER**
2134	

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/518,048	BARRITZ ET AL.	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) *30-33,44 and 45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29,34-43 and 46-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 March 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the previous office action, claims 1-14, 34, and 49-51 have been amended. Claims 1-29, 34-43, and 46-57 have been examined.

Specification

2. The use of the trademark UNIX® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-8, 10, 12, 14-25, 27, 28, 34-41, 48, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,105,069 to Franklin et al. (hereinafter "Franklin")

As per claim 1, 10, 14, and 34, and the Licensing Controller disclosed by Franklin, which constitutes a knowledge base facility, organizes databases into objects, such as for users, resources (such as computers or software application objects), and software licenses (see column 4, line 17 to column 5, line 50). The resources are organized into a database (see column 2, lines 29-33) that constitutes an inventory list. A linking between resource and license objects is also described (see column 10, lines 50-60). Franklin also includes a query tool (see column 4, line 66 to column 5, line 21) for using the various databases that outputs query results.

Franklin does disclose embodiments wherein the product is used for database maintenance by an administrator rather than for the direct execution of a software product, including the display of linked data (see column 16, lines 12-23 and figures 11 and 12). Since the operation of the licensed software is not essential for this functionality, the negative limitations of Applicant's claims are anticipated.

Regarding claims 2, 3, 35, 36, it is disclosed that the system may be run on a single system (see column 4, line 6) or a network of computers. Any package that can be run on a single system inherently can be used on a mainframe.

As per claims 4-6, 37-39, a "numbers" attribute tracks installations, while the "metering" attribute may track actual usage (see column 11, lines 33-57).

As per claims 7, 40, 41, licensing attributes may include multiple contract terms, such as the charges (see column 6, lines 28-40).

As per claim 8, the "terms" includes data for determining the number of installations (see column 11, lines 34-40).

As per claim 12, the linking data is implemented for a many-to-many relationship.

As per claims 15-21, 24, the "methods" fields permit automatic execution.

Regarding claim 22, modern computers are inherently able to do such correlations as least ten times faster than can be done by manual process.

Regarding claim 23, 48, Franklin is inherently capable of correlating up to 100% of the data.

As per claim 25, Franklin discloses the direct creation and modification of the resource databases.

Regarding claim 27, all products in the software license object may be correlated when reviewing licenses, regardless of the state of the resource database.

As per claim 28, all databases contain user-configurable attributes.

As per claim 56, Franklin discloses that the directory services system is highly distributed among nodes; therefore, any database may be on any computer in the network (see column 4, lines 45-51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 9 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al.

Regarding claim 9, Franklin does not disclose the inclusion of the entire text of an agreement in the database.

Official notice is given that the method of including official documents, such as contracts, in databases relevant to those contracts, in order to provide users an easy, unquestionable reference, is well-known in the art.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by including the entire text of an agreement in the linking file, as is well-known in the art, in order to provide users an easy, unquestionable reference.

Regarding claim 29, though Franklin discloses a metering attribute for determining usage levels over a time period, it is not specifically disclosed that correlations be made based upon the value of the metering attribute (see column 11, line 58 to column 12, line 4).

Official notice is given that it is well-known in the art that the efficiency of usage of a commodity can be determined by testing the value of its metering attribute.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by testing the value of the metering attribute, as is well-known in the art, in order to determine the efficiency of software usage.

5. Claims 11, 13, 26, 46, 47, 50-52, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claims 1, 15, and 34, above, and further in view of U.S. Patent No. 6,049,799 to Mangat et al.

Regarding claims 11, 50-52, 54, and 55, the "backlink" attribute disclosed by Franklin provides the means for the immediate updating of linking information when information in the corresponding tables are changed (see column 12, lines 13-27); however, no disclosure is given as to when the updating should actually take place.

Mangat discloses the updating of linking information upon the updating of the corresponding application (see column 11, lines 3-10), and suggests that this is to establish and re-make links (see column 2, lines 9-13).

Regarding claims 13, 26, 46, and 47, though Franklin discloses the use of different distinguished names to identify objects (see column 5, lines 22-30), a method for correlating objects based upon their distinguished names is not disclosed.

Mangat discloses the use of fuzzy logic to associate different documents with similar distinguished names (see abstract).

Mangat further suggests that this all is to establish and re-make links (see column 2, lines 9-13).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by updating of linking information upon the updating of the corresponding applications, and by using fuzzy logic to associate databases by their distinguished names, as disclosed by Mangat, in order to establish and re-make links.

6. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of U.S. Patent No. 5,867,714 to Todd et al.

Though Franklin discloses a means for incorporating new software product data into the database, the way in which software products are acquired is not disclosed (see column 15, lines 3-17).

The software distribution system disclosed by Todd distributes software from a remote server to computers (see abstract), and suggests that this allows for the remedying of faults before they actually become faults (see column 3, lines 1-8).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by distributing software from a remote server to computers on a periodic basis, as disclosed by Todd, in order to remedy problems before they actually become faults.

7. Claims 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. in view of U.S. Patent No. 6,049,799 to Mangat et al.as applied to claim 52 above, and further in view of Elmasri et al., "Fundamentals of Database Design," 1989, pp. 544-545.

Franklin and Mangat do not disclose the updating of databases on a periodic basis.

Elmasri discloses the updating (committing) of databases periodically at checkpoints, and suggests that this aids recovery in the event of a system crash.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to update the databases using checkpoints, in order to aid recovery in the event of a system crash.

8. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 56 above, and further in view of U.S. Patent No. 5,930,764 to Melchione et al.

Franklin does not disclose any collecting of industry-wide information for consideration.

Mechione discloses the collecting of industry-wide information at a central database for distribution (see abstract), and suggests that this allows individual salespersons to maximize customer satisfaction (see column 5, lines 26-28).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use industry-wide information at a central database, in order for individual salespersons to maximize customer satisfaction.

Double Patenting

9. In view of the abandonment of copending Application No. 09/732,386, the double patenting rejections are withdrawn.

Response to Arguments

10. Applicant's arguments, see Remarks, filed 6 June 2005, with respect to the rejection under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The rejections under 35 U.S.C. 112, first paragraph have been withdrawn. Applicant's specification discloses a system wherein the negative limitations of the amended claims are adequately supported.

11. Applicant's arguments filed 6 June 2005 regarding the rejections under 35 U.S.C. 102 and 35 U.S.C. 103 have been fully considered but they are not persuasive.

In response to applicant's argument that Applicant's invention is a reporting tool rather than a license manager, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding Applicant's argument that Franklin's invention directly affects the operation of software, it is noted that Franklin discloses modes in which the operation of software is not critical to Franklin's invention, such as during administrative functions.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH

August 11, 2005

GREGORY MORSE
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